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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,120	09/18/2002	Scott C. Harris	GPSPrivC1	8217

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EXAMINER
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ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/065,120

Applicant(s)

HARRIS, SCOTT C.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-13,15-20,22-31, 35, and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-13,15,17-20,22-31 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9-15, 17-20, 22-31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al in view of Seiple et al.

3. Lemelson et al teach a remote security location device 10 (Figure 3) including bi-directional communication means 24 (cellular), position computing means 34 (position detection module), processor 12, interface 25 coupled to input means 26 (manual actuating means), and display means 27. Various operational modes are envisioned for providing privacy where an actual owner will not want arbitrary polling and determination of location (col. 4, lines 43-47) including control of privacy from the remote only (col. 5, lines 7-25). The position computing means is envisioned as a GPS receiver (position detection module) whereas the bi-directional communication means is envisioned as operable in a satellite communication network such as Iridium and thus meets the scope of a cellular telephone. The entry of PIN information provides an override control actuated to enhance privacy by preventing transmission of the location information while maintaining the operation of the two-way communications.

4. Lemelson et al differ from the claimed subject matter since the override control does not prevent the determination of position (claims 1, 3, 11, 22, and 29) and since the override control is not specified as a single button being pressed (9, 10, and 20).

5. Seiple et al teach a portable unit housing a GPS receiver and a two-way communication device for communicating and providing tracking between the portable device and remote base station. Figure 2A shows the components of the portable device including activation switch(es) 30 to provide unit activation, distress initialization, exiting modes and/or cancel codes (col. 6, par. 4),

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features include placing the GPS receiver into a standby or sleep mode between the times that the signals are received from satellites to obtain position fixes.

6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lemelson et al by incorporating the power conservation features of Seiple et al by placing the GPS receiver into a standby mode during the times when it is not required and thereby reduce the power drain of the battery of the portable device. Since Lemelson et al teach not providing the GPS location information to the central station to provide enhanced security, it would have been obvious to place the GPS receiver into a standby mode to conserve battery since the position information is not required. Thus, the combination of Lemelson et al and Seiple et al suggest to the skilled artisan to not report as well as to not determine position, since shutdown of the GPS receiver when it is not required for a position fix conserves power, upon selection of a privacy code by the user.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an indicator for providing an indication to the user that the controlled access is either enabled or disabled in order to know whether to disable or enable respectively based on the user's requirements. Lastly, it would have been obvious to one having ordinary skill in the art to utilize a single dedicated button in view of the teachings of Lemelson et al who clearly suggest entry of an inhibiting number via the keyboard; there is nothing to negate the use of a single number to provide the activation. Furthermore, the menus typically utilized for electronic devices, whether it be a cellular phone, a GPS receiver, or a PDA, for selection of various operational settings are utilized so as to not crowd the keypad and so as to place features utilized most often in convenient places. It would not involve any unobvious skill to select a single button on the face of the portable device as opposed to one or a sequence of numeric keypad buttons to provide a dedicated button reserved for a specific action.

7. Applicant argues (1) the combination with Seiple et al would destroy the intended function of Seiple et al and (2) the combination does not suggest the claimed limitations including that none of the references suggest (1) why it might be advantageous to prevent GPS from being produced since the references suggest merely preventing position from being sent (claims 1, 3, 11, 22, 29 and 31); (2) use of a single button to provide the override control (claims 9, 10, and 20); and, (3) an optical indicator indicating an override condition (28, 18, 19, 26, 27, and 35).

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8. Firstly, applicant's remarks with respect to Seiple et al are contrary to the teachings therein, and the Examiner's use of the teachings of Seiple et al in no way defeat the purpose of Seiple et al. Seiple et al clearly disclose placing the tracking device into a standby/sleep mode between the times that a position fix is needed. Thus, to use such a feature of placing the GPS receiver in a standby mode in Lemelson et al does not defeat the purpose of Seiple et al since Seiple et al directly teach the placing of the GPS receiver in a sleep mode to conserve power. Applicant's argument that Seiple et al could not wait 5 to 10 minutes for data is not an accurate reading of Seiple et al who state that a worst case scenario would be approximately 3-4 minutes if there is no valid ephemeris or almanac data available; however, Seiple et al disclose downloading this information while on-board the base station, thus it is assumed that such data exists. Applicant's argument that GPS data is constantly being obtained is unsubstantiated and contrary to the teachings of Seiple et al (see col. 7, par 3-4). Applicant's argument that preventing the position detection module from determining position is contrary to the teachings of Seiple et al is not convincing since it is an inaccurate statement. Seiple et al clearly teach preventing the position detection module from determining position by placing the device into a sleep/standby mode until another fix is required. Furthermore, the teachings to be gleaned from Seiple et al are that when during periods when GPS position is not required, shutting down the calculation portion until another fix is required in order to conserve power. In Lemelson et al, during selection of the privacy mode when position is not to be transmitted, it is also not required to be calculated and thus can be placed in a shutdown mode without disabling the remaining portions of the device.
9. The applicant's argument that a PIN must be entered remotely is incorrect and, thus, is not convincing since the embodiment wherein "PIN use from remote only" discloses the user of the remote entering the PIN override function. The "stolen item" embodiment discussed by applicant is therefore outside the scope of the cited embodiment. The teaching of Lemelson et al to provide user activation via the keypad makes obvious the use of a dedicated button for reasons set forth above. The teachings of display of operational parameters on the portable devices of Lemelson et al and Seiple et al suggest to the skilled artisan to utilize an optical indicator to indicate the privacy mode selected by the user so as to make the user aware of the condition. Applicant fails to argue claim limitations with respect to claim 31. Thus, the applicant's arguments are not convincing.

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10. Claims 1-7, 9-15, 17-20, 22-31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zellner et al.

11. Zellner et al teach a wireless handheld device 200 including a location system (position detection module), a wireless communication system via network 210, and a location block device processor 204 wherein a user interface 202 on the handheld device prompts the user to enter commands initiating or suspending location blocking, including menu selections, key sequences, and graphical user interfaces (col. 6, lines 1-5). Thus, the handheld device directs either the local 204 or the remote 206 location block processors to withhold the location information. Zellner et al exemplify an embodiment as a series of menus asking the user to activate or de-activate location blocking (col. 3, par. 1). Furthermore, the user interface and the location block device processor could be a single component of a wireless hand-held device (col. 3, par. 2). Moreover, the user could select the option by entering a command before each transmission or responding to prompts before each transmission, thus suggesting the use of an optical indicator to alert the user of the blocking features.

12. Zellner et al differ from the claimed subject matter since the description of the override control as a single button is not specifically recited. However, in view of the teachings of Zellner et al regarding the user activation via a menu question (activate/deactivate), the integration of the user interface and block device processor as a single component, and activation via a prompt prior to each transmission, Zellner et al are deemed to suggest to the skilled artisan to respond to a prompt with a press of a button yes/no to activate/deactivate the block condition.

13. Applicant argues that Zellner et al require remote access to the tracked device. This is contrary to the teachings of Zellner et al and is therefore not convincing since location block device processor 204 is incorporated within the wireless hand-held device and is directly coupled to the location system 220 and the user interface 202. Applicant argues that Zellner et al merely prevent position from being sent whereas various claims of the instant case (particularly independent claims 1 and 3, and dependent claims 11, 22 and 29) teach prevention of position determination. This is not convincing since Zellner et al disclose in col. 6, location block "processors 204 and 206 can disable a location system and substitute dummy information.." Moreover, claim 1 of Zellner et al disclose "a location block processor in communication with the location system and the user interface, wherein the location

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block processor receives directions from the user interface to prevent inclusion of the location information from the transmissions and disables the location system." Thus, Zellner et al teach both prevention of location information transmission as well as disabling the location system wherein the location system is, as defined in claim 2, a GPS receiver. The menus/prompts provide an optical indication to the user for providing the activation or deactivation of the blocking of the location system. The use of an illuminated display on a cell phone is well-known in the art and as such when the prompt is displayed, the display screen would obviously be illuminated. Furthermore, the use of a dedicated button to provide a logical on/off of an operational characteristic of a wireless electronic device would have been within the skill of the artisan and the scope of the prior art.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

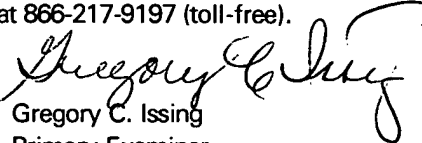
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is currently 703-306-4156; as of April 4, the new number will be 571-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on 703-306-4171 (new number will be 571-272-6979). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory C. Issing  
Primary Examiner  
Art Unit 3662

Gci